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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,759	02/19/2002	Kenneth D. Hope	09/588103US1	6373

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EXAMINER	
NGUYEN, TAM M	

ART UNIT	PAPER NUMBER
1764	6

DATE MAILED: 03/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/078,759	HOPE ET AL.	
	Examiner	Art Unit	
	Tam M. Nguyen	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 February 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-18 and 23-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-18 and 23-27* is/are rejected.

7)☒ Claim(s) *16 and 27* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16-18 and 23-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16, 20, 32, and 33 of U.S. Patent No. 6,395,948. Although the conflicting claims are not identical, they are not patentably distinct from each other because (A) the process of claims 16 and 33 of the U.S. Patent claims a process for producing a polyalphaolefin product having a viscosity of at least 22 centistokes at 100° C. The process of claims 16 and 33 of the U.S. Patent does not claim that the polyalphaolefin composition has a viscosity of at least 30 at 100° C, does not claim that the polyalphaolefin has a dimer content of less than 2 weight percent, and does not claim that the polyalphaolefin composition has a pour point of less than –30° C. However, the polyalphaolefin composition of claims 16 and 33 of the U.S. Patent and the polyalphaolefin composition of the present claims are produced by the same as the. Therefore, it would be expected that the polyalphaolefin composition of claims 16 and 33 of the U.S. Patent would have the same characteristics as claimed in claims 16-18 and 23-27 of the present application. (B) The process of claims 20 and

32 of the U.S. Patent claims a process for producing a polyalphaolefin product having a viscosity of at least 22 centistokes at 100° C and content less than 2 weight percent of dimer. The process of claims 20 and 32 of the U.S. Patent does not claim that the polyalphaolefin composition has a viscosity of at least 30 at 100° C and does not claim that the polyalphaolefin composition has a pour point of less than –30° C. However, the polyalphaolefin composition of claims 20 and 32 of the U.S. Patent and the polyalphaolefin composition of the present application claims are produced by the same as the process. Therefore, it would be expected that the polyalphaolefin composition of claims 20 and 32 of the U.S. Patent would have the same characteristics as claimed in claims 16-18 and 23-27 of the present application.

Claim Objections

The expression "the process of claim 1" in line 2 of claim 16 is objected because claim 1 was canceled. The examiner suggests that applicant amends claim 16 to be an independent claim. Appropriate correction is required.

Claim 27 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation "not less than 22 cst at 100° C" in claim 27 is not further the limitation "in excess of 22 cst at 100° C" in the last line of claim 23. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16, 17, 23, and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Wu (4,827,064).

Wu discloses a polyalphaolefin product which has a viscosity in between 3-5000 centistokes at 100° C and has a pour point of less than –30° C. (See abstract; col. 4, line 63 through col. 5, line2; tables 2-3; examples 16-18).

Claims 16 and 23:

It is reminded that the present claimed process is a product-by-process claim and the patentability of a product does not depend on its method of production. The Wu polyalphaolefin product is substantially identical to the claimed polyalphaolefin product. (See col. 4, lines 18-30) This is deemed to anticipate the limitation of claims 16 and 23.

Claims 17, 25, and 27:

A polyalphaolefin product has a viscosity at 100° C of 145 and 298 centistokes (see col. 4, lines 18-30). This is deemed to anticipate the limitation of claims 17 and 25.

Claim 26

A polyalphaolefin product has a pour point of –55° C, –40° C, and – 32° C (See col. 4, lines 18-30). This is deemed to anticipate the limitation of claim 26.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (4,827,064).

The product of Wu is as stated above.

Claims 18 and 24:

Wu does not disclose that the polyalphaolefin product comprises less than 2 weight percent of dimer. However, Wu discloses that dimer can be separated from the oligomer composition (polyalphaolefin) by distillation (see col. 4, line 63 through col. 5, line 13; col. 6, lines 66-68). Therefore, it would have been obvious to one having ordinary skill in the art at the

time the invention was made to have modified the process of Wu by separating dimer from the polyalphaolefin product to produce a polyalphaolefin product comprises less than 2 weight percent of dimer because one of skill in the art would separate dimer from the polyalphaolefin product if one desires to obtain a polyalphaolefin product which comprises less than 2 wt.% of dimer.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam M. Nguyen whose telephone number is (703) 305-7715. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 703-308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tam M. Nguyen
Examiner
Art Unit 1764

Tam Nguyen/ TN
March 19, 2003